

## **REMARKS**

This Response is submitted in reply to the Non-Final Office Action dated April 8, 2009. Claims 1 to 25, 27, and 28 are pending in this application. Claims 1 to 25, 27, and 28 are rejected. Claim 26 stands previously cancelled. The Director is authorized to charge Deposit Account No. 02-1818 for any fees which may be required in connection with this Response, or to credit any overpayment. If such a withdrawal or credit is made, please indicate Attorney Docket No. 0112857-00472 on the account statement.

### **Claim Rejections Under 35 U.S.C. § 101**

The Office Action rejected Claims 21 to 25 under 35 U.S.C. § 101 because the claims are directed to non-statutory subject matter. Applicant respectfully disagrees with, and traverses, this rejection.

Page 2 of the Office Action states that “[n]o physical structural elements are recited...” and “[t]he body of the claims comprises software modules, which are virtual modules not physical structures.” Applicant respectfully disagrees and submits that these claims do recite structure in accordance with 35 U.S.C. § 112, sixth paragraph. Specifically, independent Claim 21 recites, in part: “[a]n information processing apparatus for managing electronic values, said apparatus comprising: electronic-value payment means for making an electronic payment...; payment notification sender means for transmitting a payment notification...; and electronic-value managing means for managing...”

As stated in section 2181(II) of the MPEP, “35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language ‘shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.’” Applicant respectfully submits that the corresponding structure of the claimed limitations are described in the specification at least as follows:

- (1) “electronic-value payment means for making an electronic-value payment to a first main apparatus for providing a resource to a terminal operated by a user as a payment, which is made for a price to provide said resource from said first main apparatus to said terminal, in accordance with a request made by a second main apparatus for storing personal information of said user” is supported at least in paragraphs [0263] to [0287], and in

Figures 15 and 16 of the published specification. Specifically, paragraph [0269] of the published specification states: “[t]he value issuance section 135 is a unit for issuing a value on the basis of a value (or, strictly speaking, and electronic value) stored in the value storage section...” Paragraph [0276] of the published specification states: “[t]he payment-notification transmission processing is started when the value issuance apparatus 14 receives a request for a value transfer transmitted by the main apparatus 12-2...” Paragraph [0284] of the published specification states, in part:

[i]n a process carried out at the step S167, the value issuance section 135 transfers a value from the main apparatus 12-2 to the main apparatus 12-1. To put it concretely, the value issuance section 135 deletes a value corresponding to a predetermined price stored in the value storage section 140 as a price of the main apparatus 12-2 and adds the value as a value corresponding to a predetermined price to the value of the main apparatus 12-1. Thus, an electronic value of the user of the main apparatus 12-2 is paid as a price to utilize a resource connected to the main apparatus 12-1 to the user of the main apparatus 12-1 when the user of the main apparatus 12-2 makes an attempt to utilize the resource.

- (2) “payment-notification sender means for transmitting a payment notification to said first main apparatus to notify said first main apparatus of said electronic-value payment made to said first main apparatus from said second main apparatus...” is supported in the specification at least in paragraph [0286] which states, in part:

[t]hen, the public-key authentication section 134 creates a payment notification text with the encrypted digital signature added thereto. The payment notification includes a payment notification for reporting the payment of a value and a receipt describing details of the payment of the value. Subsequently, the public-key authentication section 134 transmits the payment notification text, the electronic certificate stored in the certificate storage section 138 and the transaction-result notification revealing completion of the electronic-value transfer to the main apparatus 12-1 serving as the payee of the electronic-value payment.

- (3) “electronic-value managing means for managing said electronic values in the form of an account managed by using an apparatus ID included in a certificate of each of said main apparatus or by using an ID associated with said apparatus ID...” is supported by the specification at least in paragraph [0275] of the published specification which states:

[i]n addition, values can be stored in a storage combination of the value storage section 140 employed in the value issuance apparatus 14 and a safe device employed in the main apparatus 12. To put it concretely, a

value of every user is stored in the value storage section 140 employed in the value issuance apparatus 14 in the form of an account managed by the value issuance apparatus 14 as the account for the user and only a required value is transferred to a safety device (for example, the non-contact ID) owned by the user to serve as the wallet of the user.

Accordingly, the limitations of independent Claim 21, expressed in means-plus-function language in accordance with 35 U.S.C. § 112, sixth paragraph include, at a minimum, the corresponding structure as described in the specification.

Regarding Claim 22, paragraphs [0294] to [0305] and Figures 17 and 18 of the published application describe the structure and process for authenticating the information processing apparatus in conjunction with the first and second main apparatuses as a valid apparatus for managing electronic values. Therefore, the structure of the “authentication means” of Claim 22 is sufficiently described in the specification.

Regarding Claims 23 and 24, paragraph [0274] of the published specification states:

[f]urthermore, a value is not stored only in the value storage section 140 employed in the value issuance apparatus 14 in the form of an account, but also in a storage area of a safe device employed in the main apparatus 12. An example of the safe device is the non-contact IC card 121. In this case, an electronic value issued by the value issuance section 135 employed in the value issuance apparatus 14 is transferred to the non-contact IC card 121. When the value issuance apparatus 14 makes a payment of a value from the main apparatus 12-2 to the main apparatus 12-1, for example, the value issuance apparatus 14 acquires a value from the main apparatus 12-2 and transfers the value to the main apparatus 12-1. It is to be noted that a value is transferred after being encrypted in order to allow the value to be transmitted from one apparatus to another safely.

Therefore, the structure of the “storage means” and the “electronic-value payment means” of Claims 23 and 24, respectively, are sufficiently described in the specification.

Therefore, Applicant respectfully submits that these claims recite sufficient structure for achieving the function recited in these claims. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 112**

The Office Action rejected Claims 21 to 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Applicant respectfully disagrees with, and traverses, this rejection.

Page 3 of the Office Action states: “[i]t is unclear what or which information-processing apparatus Applicant is referring to rendering the claim unclear and indefinite.” Applicant respectfully disagrees and submits that, as stated above, the specification clearly defines the structure of each of the elements of the information-processing apparatus of independent Claim 21. Therefore, Applicant respectfully requests that this rejection be withdrawn.

The Office Action rejected Claims 9 to 11 under 35 U.S.C. § 112, sixth paragraph, as failing to disclose the corresponding structure, material, or act for the claimed function. Applicant respectfully disagrees with, and traverses, this rejection.

Applicant directs the Examiner’s attention to section 2181(II) of the MPEP which states, in part:

disclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description if it would have been clear to those skilled in the art what structure must perform the function recited in the means-plus-function limitation. See *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1379, 53 USPQ2d 1225, 1228 (Fed. Cir. 1999) (stating that the “one skilled in the art” analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation and that the USPTO’s recently issued proposed Supplemental Guidelines are consistent with the court’s holding on this point);

See, also, the MPEP’s discussion of *In re Dossel* in § 2181(III):

The function recited in the means-plus-function limitation involved “reconstructing” data. The issue was whether the structure underlying this “reconstructing” function was adequately described in the written description to satisfy 35 U.S.C. 112, second paragraph. The court stated that “[n]either the written description nor the claims uses the magic word ‘computer,’ nor do they quote computer code that may be used in the invention. Nevertheless, when the written description is combined with claims 8 and 9, the disclosure satisfies the requirements of Section 112, Para. 2.” The court concluded that based on the specific facts of the case, one skilled in the art would recognize the structure for performing the “reconstructing” function since “a unit which receives digital data, performs complex mathematical computations and outputs the results to a display must be implemented by or on a general or special purpose computer.”

Page 3 of the Office Action states that the written description fails to sufficiently disclose the structure for performing the claimed functions “receiving a payment”, “issuing a right”, “authenticating said value apparatus”, and “authenticating said payment notification.” Applicant respectfully disagrees and submits that the structure for performing these claimed functions is

disclosed, explicitly or at a minimum inherently, at least in Figures 6, 7, and 14, and the following paragraphs of the published specification:

(1) paragraph [0176]: “The antenna 94 is a component for receiving a signal from a mobile terminal 11 and supplying the signal to the reception section 95. The antenna 94 is also a component for transmitting a signal received from the transmission section 96 and to a mobile terminal 11...”;

(2) paragraph [0253]: “processing to be carried out by the main apparatus 12-1 to issue a right text is started when the main apparatus 12-1 receives a payment notification and an electronic certificate...”;

(3) paragraph [0260]: “[i]f the determination result produced by the CPU 111 employed in the main apparatus 12-1 in a process carried out at the step S156 indicates that the electronic-certificate evaluation received from the authentication apparatus 13 shows a valid electronic certificate, that is, the electronic certificate received from the main apparatus 12-2 along with a utilization-right issuance request text is valid, the flow of the processing goes on to a step S157 at which the CPU 111 employed in the main apparatus 12-1 electronically creates a right text describing a right to utilize a resource...”; and

(4) paragraph [0256]: “the CPU 111 employed in the main apparatus 12-1 produces a result of determination as to whether or not the digital signature encrypted by the private-key 43 has been correctly decrypted using the public-key 41 forming a pair in conjunction with the private-key 43 . . . [i]f the result of the determination indicates that the digital signature encrypted by the private-key 43 has been correctly decrypted using the public-key 41, the CPU 111 employed in the main apparatus 12-1 recognizes no interpolation carried out on the communication line between the main apparatus 12-1 and the value issuance apparatus 14, determining that the payment notification is valid.”

Therefore, at least because the corresponding structure for performing the claimed elements is disclosed in the specification, Applicant respectfully requests that this rejection be withdrawn.

The Office Action rejected Claims 15 to 17 under 35 U.S.C. § 112, sixth paragraph, as failing to disclose the corresponding structure, material, or act for the claimed function. Applicant respectfully disagrees with, and traverses, this rejection.

Page 3 of the Office Action states that the written description fails to sufficiently disclose the structure for performing the claimed functions “requesting a value”, “acquiring a utilization right”, “providing a utilization right”, “authenticating said value apparatus”, and “authenticating said user.” Applicant respectfully disagrees and submits that the apparatus of Claim 15 does not include an electronic-value payment request means for merely “requesting a value”. Rather, the apparatus of Claim 15 includes an electronic-value payment request means for “requesting a value apparatus for managing electronic values to make an electronic-value payment...” Furthermore, Applicant submits that the that the structure for performing these claimed functions is disclosed, explicitly or at a minimum inherently, at least in Figures 6, 9, and 10, and the following paragraphs of the published specification:

(1) paragraph [0226]: “the CPU 111 employed in the main apparatus 12-2 transmits a value transfer request to transfer a value from the main apparatus 12-2 to the main apparatus 12-1, that is, a value transfer request to make a payment on behalf of the main apparatus 12-2 to the main apparatus 12-1, to the value issuance apparatus 14...”;

(2) paragraph [0218]: “the CPU 111 employed in main apparatus 12-2 creates a utilization-right issuance request text and an electronic certificate stored in the RAM 113 and transmits the utilization-right issuance request text and the electronic certificate to the main apparatus 12-1, which is not the base main apparatus of the mobile terminal 11-1 making an attempt to utilize a resource connected to the main apparatus 12-1...”;

(3) paragraph [0214]: “the CPU 111 employed in the main apparatus 12-1 transmits the acquired resource to the mobile terminal 11-2...”;

(4) paragraph [0282]: “If the determination result produced by the common private-key authentication section 133 in the process carried out at the step S166 indicates that the decrypted common private-key 37 is equal to the common private-key 44, the common private-key authentication section 133 recognizes a valid relation between the main apparatus 12-2 and the value issuance apparatus 14...”;

(5) paragraph [0207]: “[i]f the determination result produced by the CPU 111 in the process carried out at the step S62 indicates that a signal making a request for a resource has been received from the mobile terminal 11-1, the flow of the processing goes on to a step S73 at which resource transmission processing is carried out.”

Therefore, at least because the corresponding structure for performing the claimed elements is disclosed in the specification, Applicant respectfully requests that this rejection be withdrawn.

The Office Action rejected Claim 21 under 35 U.S.C. § 112, sixth paragraph, as failing to disclose the corresponding structure, material, or act for the claimed function. Applicant respectfully disagrees with, and traverses, this rejection.

Page 3 of the Office Action states that the written description fails to sufficiently disclose the structure for performing the claimed functions “making an electronic-value payment”, “transmitting a payment notification”, and “managing said electronic values.” Applicant respectfully disagrees, and submits that the specification sufficiently discloses the structure for performing these functions at least in the figures and paragraphs as described above with respect to Claim 21 and the 35 U.S.C. § 101 rejection.

Therefore, at least because the corresponding structure for performing the claimed elements is disclosed in the specification, Applicant respectfully requests that this rejection be withdrawn.

### **Rejections Under 35 U.S.C. § 103**

The Office Action rejected Claims 1 to 25, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0103063 to Takayama et al. (“Takayama”). Applicant respectfully disagrees with, and traverses, this rejection.

Applicant respectfully submits that the Office Action improperly rejected these claims under 35 U.S.C. § 103(a). As stated in Section 2142 of the MPEP, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.” This section further states that “[t]he key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” As stated in

Section 2143.03 of the MPEP, “[w]hen evaluating claims for obviousness under 35 U.S.C. §103, all the limitations of the claims must be considered and given weight...” Furthermore, 37 C.F.R. 1.104(c)(2) states, in part, “[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command” and “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.”

Applicant respectfully submits that the Office Action did not establish a prima facie case of obviousness because it fails to consider and give weight to all of the claimed elements, and fails to clearly articulate the reasons why the Office Action interprets the claimed invention to be obvious.

For example, independent Claim 1 recites, in part, “. . . resource-request signal sender means for transmitting a signal making a request for a resource provided by said first main apparatus to said second main apparatus through said first main apparatus . . .” (Emphasis added). Independent Claim 1 also recites, in part, a first main apparatus for allowing the terminal to utilize a resource and “. . . for receiving a payment notification from said value apparatus as a notification informing said first main apparatus that an electronic value representing a price to utilize a resource has been paid from said second main apparatus as an electronic-value payment to said first main apparatus . . .” Nothing in the Office Action designates the particular part of Takayama that the Office Action relies on for disclosure of these elements. Moreover, nothing in the Office Action sets forth any proposed modification to Takayama to arrive at these claimed elements, nor does the Office Action provide any explanation as to why these claimed elements would have been obvious to one having ordinary skill in the art at the time the invention was made.

Accordingly, Applicant respectfully requests that this rejection be determined to be an improper rejection, and that any subsequent action on the merits be non-final and consider and give weight to all of the claimed elements.

Applicant therefore reiterates Applicant’s previously presented argument regarding Claims 1, 2, 7, and 8, that Takayama fails to disclose or render obvious, at a minimum, an information-processing system which includes a terminal “transmitting a signal making a request



for a resource provided by said first main apparatus to said second main apparatus through said first main apparatus.” For example, Takayama is silent regarding the portable terminal 5 making a request to a second main apparatus through the service server 3 or the service terminal 4 which provide the service. See Takayama, paragraphs [0135]-[0145] and Fig. 1. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Takayama to arrive at such an information-processing system without reasonably being construed as impermissible hindsight reconstruction. If the Examiner disagrees, Applicant respectfully requests that in any subsequent action on the merits, the Examiner particularly point out, with specific references to Takayama, which elements of Takayama the Examiner interprets as anticipating or rendering obvious these features.

Additionally, Regarding Claims 1, 9, 13, and 14, Takayama fails to disclose or suggest, at a minimum, an information-processing system which includes a first main apparatus for allowing the terminal to utilize a resource and “for receiving a payment notification from said value apparatus as a notification informing ‘said first main apparatus that an electronic value representing a price to utilize a resource has been paid from said second main apparatus as an electronic-value payment to said first main apparatus.” Instead, Takayama teaches the service server 3 or the service terminal 4, which provides the service, receives a “use of electronic value” from either the bank 7 or the portable terminal 5 but not from the electronic value issuing server 2. See Takayama, paragraphs [0135]-[0145] and Fig. 1. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Takayama to arrive at such an information-processing system without reasonably being construed as impermissible hindsight reconstruction. If the Examiner disagrees, Applicant respectfully requests that in any subsequent action on the merits, the Examiner particularly point out, with specific references to Takayama, which elements of Takayama the Examiner interprets as anticipating or rendering obvious these features.

Regarding Claims 1, 15, 19, 20, Takayama fails to disclose or suggest, at a minimum, an information-processing system which includes a second main apparatus “for requesting said value apparatus to make an electronic-value payment for an electronic value to said first main apparatus in accordance with a signal received from said terminal as a signal making a request

for a resource.” Takayama teaches the bank 7 receives a “transfer of electronic value” from the electronic value issuing server 2 but fails to disclose or suggest the bank 7 requesting anything from the electronic value issuing server 2. Instead, the portable terminal 5, not the bank 7, sends an “electronic value issue request” to the electronic value issuing server 2. See Takayama, paragraphs [0135]-[0145] and Fig. 1. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Takayama to arrive at such an information-processing system without reasonably being construed as impermissible hindsight reconstruction. If the Examiner disagrees, Applicant respectfully requests that in any subsequent action on the merits, the Examiner particularly point out, with specific references to Takayama, which elements of Takayama the Examiner interprets as anticipating or rendering obvious these features.

Regarding Claims 1, 21, 27, and 28, Takayama fails to disclose or suggest, at a minimum, an information-processing system which includes a value apparatus for “making an electronic-value payment to said first main apparatus in accordance with a request received from said second main apparatus.” Instead, Takayama teaches the electronic value issuing server 2 transfers an electronic value to the bank 7, and not to the service server 3 or the service terminal 4 which provide the service. Furthermore, the electronic value issuing server 2 transfers the electronic value to the bank 7 in accordance with a request from the portable terminal 5, not from a second main apparatus as claimed. See Takayama, paragraphs [0135]-[0145] and Fig. 1. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Takayama to arrive at such an information-processing system without reasonably being construed as impermissible hindsight reconstruction. If the Examiner disagrees, Applicant respectfully requests that in any subsequent action on the merits, the Examiner particularly point out, with specific references to Takayama, which elements of Takayama the Examiner interprets as anticipating or rendering obvious these features.

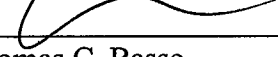
For at least these reasons, independent Claims 1, 2, 7 to 9, 13 to 15, 19 to 21, 27, and 28 are patentably distinguished over Takayama and are in condition for allowance. Claims 3 to 6, Claims 10 to 12, Claims 16 to 18, and Claims 22 to 25 depend directly and indirectly from independent Claims 2, 9, 15, and 21, respectively, and are allowable for similar reasons as given above with respect to these claims, and because of the additional features recited in these dependent claims.

For at least the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance and earnestly solicits reconsideration of the same.

The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing. If such a withdrawal is made, please indicate the Attorney Docket No. 0112857-00472 on the account statement.

Respectfully submitted,

K&L GATES LLP

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Dated: July 8, 2009